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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,071	07/08/2003	Dirk J. Rettig	52.061	7880
23598	7590	09/02/2005	EXAMINER	
BOYLE FREDRICKSON NEWHOLM STEIN & GRATZ, S.C. 250 E. WISCONSIN AVENUE SUITE 1030 MILWAUKEE, WI 53202			LUONG, VINH	
			ART UNIT	PAPER NUMBER
			3682	

DATE MAILED: 09/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/615,071	RETTIG, DIRK J.	
	<b>Examiner</b> Vinh T. Luong	<b>Art Unit</b> 3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 24 June 2005.  
 2a) This action is **FINAL**.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-4,7-11 and 13-24 is/are pending in the application.  
 4a) Of the above claim(s) 17-20 is/are withdrawn from consideration.  
 5) Claim(s) 1-4,7-11,23 and 24 is/are allowed.  
 6) Claim(s) 13-16,21 and 22 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 24 June 2005 and 08 July 2003 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
 Vinh T. Luong  
 Primary Examiner

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: Attachment.

1. The amendment filed on June 24, 2005 has been entered.
2. The drawings were received on June 24, 2005. These drawings are unaccepted by the Draftsperson because the drawings do not comply with 37 CFR 1.84 or 1.152. See attached Form PTO-948. In addition, these drawings are unaccepted by the Examiner, *inter alia*, because:
  - (a) The drawings do not comply with 37 CFR 1.84(p)(5). They do not include the reference sign(s), such as, 74 and 80 mentioned in the description; and
  - (b) The drawings do not comply with 37 CFR 1.84(p)(5). They include the reference numeral(s), such as, 70' not mentioned in the description.
3. The *original* drawings are objected to because of the reasons, e.g., listed below:
  - (a) The various parts in Fig. 5 should be embraced by a bracket in order to show their relationship;
  - (b) The drawings must not use the same referential numeral to indicate different things or *vice versa*. For example, Fig. 1 shows that the same referential numeral 60 is used to indicate both of the first upper and lower members; and
  - (c) Each part of the invention such as the selected width of the first spacer in the "wherein" clause of claim 13 and the width of the first spacer in clause b) of claim 21 should be designated by a referential numeral or character. Note that Figs. 2 and 3 have referential character H for the overall height of the assembly but no referential character for the width of the first spacer. See, e.g., page 6 of the specification.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet,

even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The disclosure is objected to because of the following informalities: the specification is inconsistent with the drawings. For example, page 6 of the specification describes the locking members 74 and the rounded engaging end 80. However, Fig. 5 shows the referential numerals 79 and 80’. Appropriate correction is required.

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter, such as, “a selected width” in claim 13 and “a width” in claim 21. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction is required.

6. Claims 13-16 are objected to because of the following informalities: no antecedent basis is seen for the term, such as, “the stem” in clause a) of claim 13. Appropriate correction is required.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 13-16, 21, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term such as “securable” in clause a) of claim 13 is vague and indefinite in the sense that things which may be done are not required to be done, *e.g.*, the first spacer is *securable*, but is not required structurally to be secured to the steer tube on one side of the stem. See “*crimpable*” and “*discardable*” in *Mathis v. Hydro Air Industries*, 1 USPQ2d 1513, 1527 (D.C. Calif. 1986), “*removable*” in *In re Burke Inc.*, 22 USPQ2d 1368, 1372 (D.C. Calif. 1992), and “*comparable*” in *Ex parte Anderson*, 21 USPQ2d 1241, 1249 (Bd. Pat. App. & Inter. 1992).

It is unclear whether a confusing variety of terms, such as, “the stem” in clause a) of claim 13 and “a handlebar stem” in clause c) of the same claim refer to the same or different things. See MPEP 608.01(o) and 2173.05(o).

In clause b) of claim 21, it is unclear the width of the first spacer in the extended position is greater than what.

Regarding claim 22, the phrase “a step-like configuration” renders the claim(s) indefinite because it is unclear what is like a step but is not a step. See “or the like” in MPEP § 2173.05(d).

Regarding claim 22/21, it is unclear whether the term that appears at least twice, such as, “a sloped surface” refers to the same or different things. See MPEP 2173.05(o).

9. Claims 13-16, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Chi (DE 199 40 969 A1).

Regarding claim 13, Chi teaches a handlebar assembly for a steer tube 8 of a bicycle, the assembly comprising:

a spacer 21, 22 securable to the steer tube 8 and including an upper member 21 and a lower member 22, each of the upper member 21 and the lower member 22 including a base (Att.) and a number of tabs (Att.) extending outwardly from one side of the base (Att.), each of the number of tabs (Att.) including a plurality of locking members 211, 221 positioned on the tab (Att.), the locking members 211 on the upper member 21 configured to engage the locking members 221 on the lower member 22; and

a handlebar stem 91 releasably securable to the steer tube 8,  
wherein the upper member 21 is configured to rotate with respect to the lower member 22 of the spacer 21, 22

wherein rotation of the lower member 22 relative to the upper member 21 causes variable adjustment of a selected width (W, see Fig. 5 of Att.) of the spacer 21, 22, and wherein the one or more of the plurality of locking members 221 of the lower member selectively interlocks with one or more of the plurality of the locking members 211 of the upper member 21 so as to secure the spacer 21, 22 at the selected width (W, see Fig. 5 of Att.).

Chi teaches the invention substantially as claimed. Particularly, Chi apparently teaches one spacer instead of two spacers (first and second spacers). Moreover, Chi's spacer is inherently *securable* to the steer tube 8 on one side of the stem 91 or on the opposite side of the stem 91.

It is common knowledge in the art at the time the invention was made to change Chi's spacer to two spacers on opposite sides of the stem in order to adjust the height of Chi's handlebar stem. The use of one spacer or two spacers on opposite sides of the stem would have been an obvious choice in design since the claimed structure and the function it performs are the

same as the prior art. See *In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995) and *Sjolund v. Musland*, 6 USPQ2d 2020, 2026 (CAFC)(the use of a plurality of panels instead of a single panel is obvious).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to change Chi's spacer to two spacers on opposite sides of the stem in order to adjust the height of Chi's handlebar stem as taught or suggested by common knowledge in the art.

Regarding claim 14, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the second spacer which is identical to Chi's first spacer in order to adjust the height of the bicycle handlebar stem, *i.e.*, the second spacer is formed of a second upper member and a second lower member, each of the second upper member and the second lower member including a base and a number of tabs extending outwardly from one side of the base, each of the number of tabs including a plurality of locking members positioned on the tab. See *In re Chu* and *Sjolund v. Musland, supra*.

Regarding claim 15, Chi teaches the invention substantially as claimed. Particularly, Chi apparently teaches one spacer instead of two spacers (first and second spacers). Moreover, Chi's spacer is inherently *securable* to the steer tube 8 on one side of the stem 91 or on the opposite side of the stem 91.

It is common knowledge in the art at the time the invention was made to change Chi's spacer to two spacers on opposite sides of the stem in order to adjust the height of Chi's handlebar stem. The use of one spacer or two spacers on opposite sides of the stem would have

been an obvious choice in design since the claimed structure and the function it performs are the same as the prior art. *In re Chu and Sjolund v. Musland, supra.*

Regarding claim 16, the lower member 22 and the upper members 21 are *adapted to* be fixedly attached to the steer tube 8 as seen in Fig. 3. Moreover, it has long been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 U.S.P.Q. 138 (CCPA 1946).

10. Claims 1-4, 7-11, 23, and 24 are allowed.
11. Claims 21 and 22 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.
12. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).
13. Applicant's arguments filed June 24, 2005 have been fully considered but they are not persuasive.

### **Drawings**

The replacement drawings have been disapproved for the reasons set forth in paragraph 2 above.

### **35 USC 112, Second Paragraph**

The Examiner agrees that Applicant overcomes the rejection under 35 USC 112, second paragraph, of claim 1 and its dependent claims. However, Applicant does not overcome the rejection under 35 USC 112, second paragraph, of claims 13-16 as seen above.

**35 USC 103(a)**

The Examiner agrees that claims 1-4 and 7-11 are patentable since Chi does not teach or suggest the new limitation “wherein the plurality of locking members are disposed on the sloping surface” in claim 1. Similarly, Chi does not teach or suggest the limitation “the sloped surface including a plurality of locking members located therealong in a stepped configuration relative to the base” in claim 21.

With respect to claim 13, Applicant contends:

For reasons similar to those described above for claim 1, the cited ‘969 Chi patent does not teach or suggest each and every limitation of claim 13 as amended. In particular, *the ‘969 Chi patent does not disclose that one or more of the plurality of locking members of the first lower member selectively interlock with one or more of the plurality of locking members of the first upper member so as to secure the first spacer at the selected width.* Rather, the ‘969 Chi patent teaches that the alleged upper member is secured relative to the alleged lower member by a screw 17 and a screw 4 (See page 5-6; Figs. 1 and 4). Accordingly, reconsideration and allowance of claim 13 is respectfully requested. (Emphasis added).

The Examiner respectfully submits that Chi patent does suggest each and every limitation of claim 13 as amended. Please see the rejection under 35 USC 103 above. In particular, the ‘969 Chi patent *does* disclose that one or more of the plurality of locking members of the first lower member selectively interlock with one or more of the plurality of locking members of the first upper member so as to secure the first spacer at the selected width as evidenced in Figs. 2 and 5 and the description on page 6 of its English translation sent to Applicant on March 22, 2005. For example, Chi stated “[a]s illustrated in Fig. 5, rotation of the second screw 4 causes the first ring member 21 to be rotated, and the second ring member 22 is pressed downwards because *the first teeth 211 slide on the second teeth 221.*” (Emphasis added).

As quoted above, when the teeth 211 slide on the teeth 221, the frictional force between Chi's teeth 211 and 221 inherently interlock with each other so as to secure the spacer 21, 22 at the selected width W in the same manner as Applicant's teeth 74. This frictional force is explained in standard physics textbook. See, e.g., the Chapter 6 of Physics, *Parts I & II*, *Halliday Resnick*, 1966, by John Wiley & Sons, Inc., attached. See *Prima Tek II LLC v. Polypap S.A.R.L.*, 75 USPQ2d 1219, 1223 (Fed. Cir. 2005)(A prior art reference may anticipate when the claim limitation or limitations not expressly found in that reference are nonetheless inherent in it . . . Inherent anticipation does not require an appreciation of the inherent limitation by those of skill in the art before the critical date of the patents in issue). See also *In re Jacopy*, 135 USPQ 317, 319 (CCPA 1962)(obviousness question cannot be approached on basis that skilled artisans would only know what they read in references; such artisans must be presumed to know something about the art apart from the references disclosed).

Accordingly, reconsideration and allowance of claims 13-16 is respectfully denied.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Luong

August 29, 2005



Vinh T. Luong  
Primary Examiner

## **ATTACHMENT**

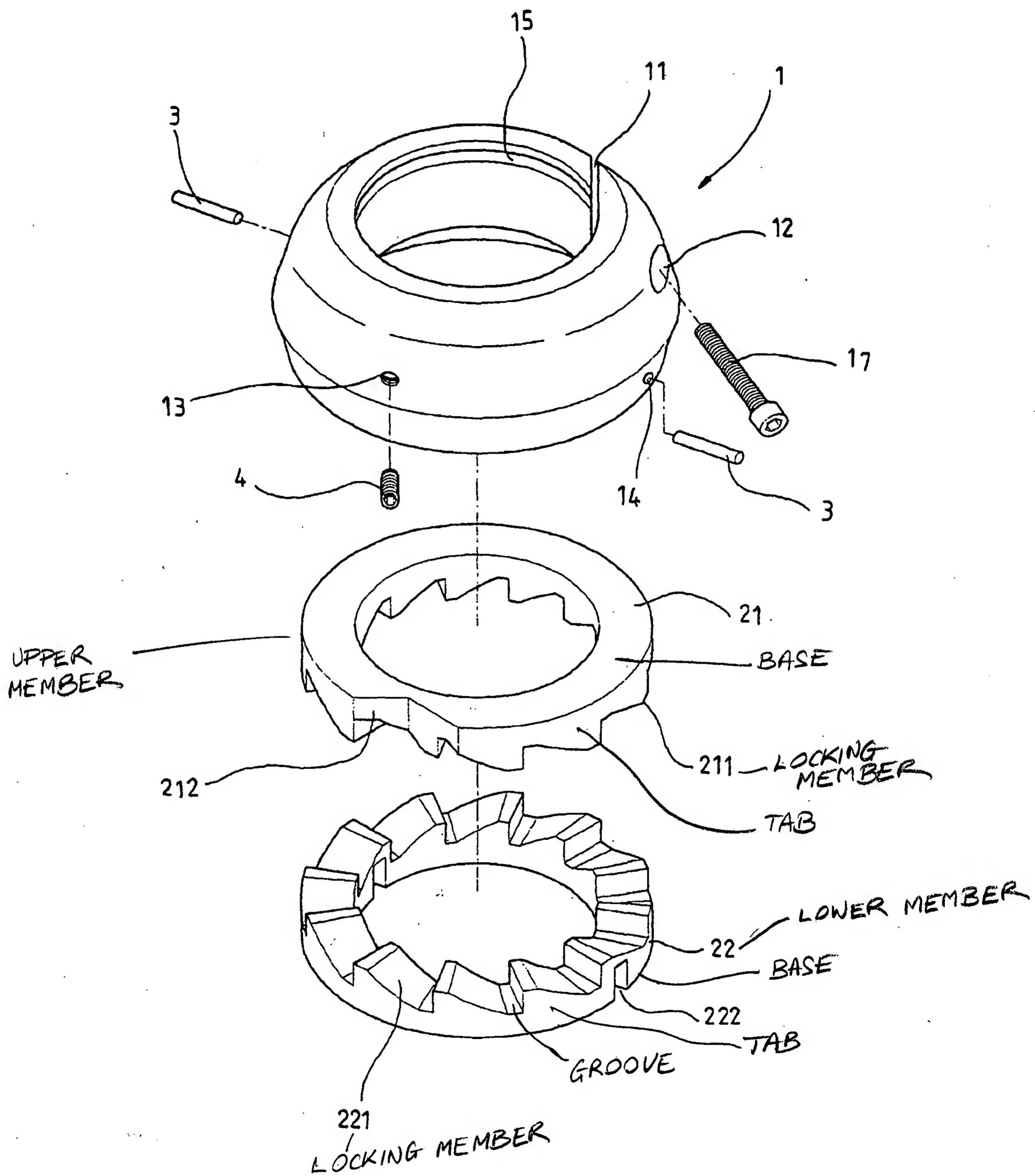
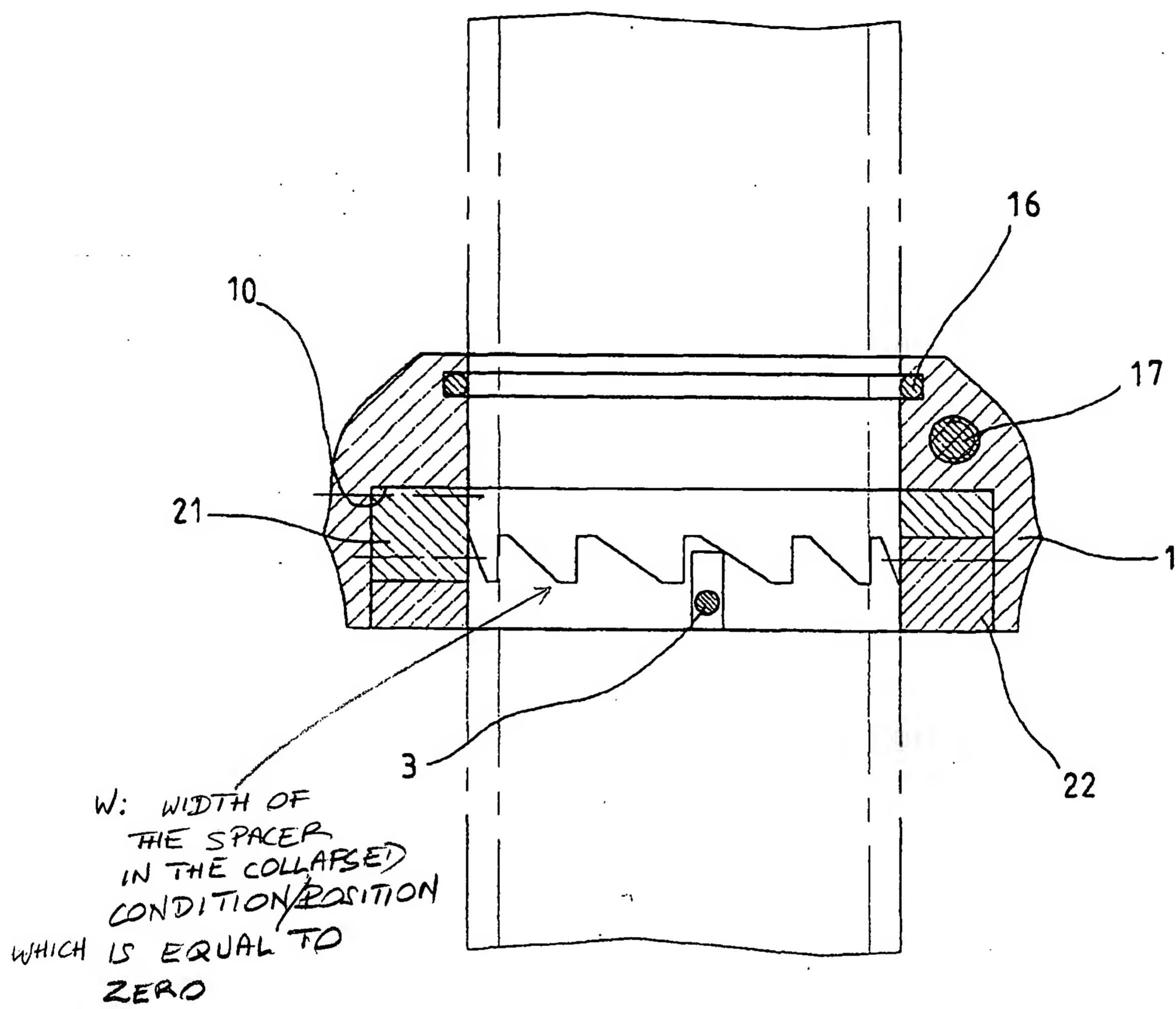


FIG. 1

PAGE 1 OF 3



**FIG.2** (COLLAPSED CONDITION)

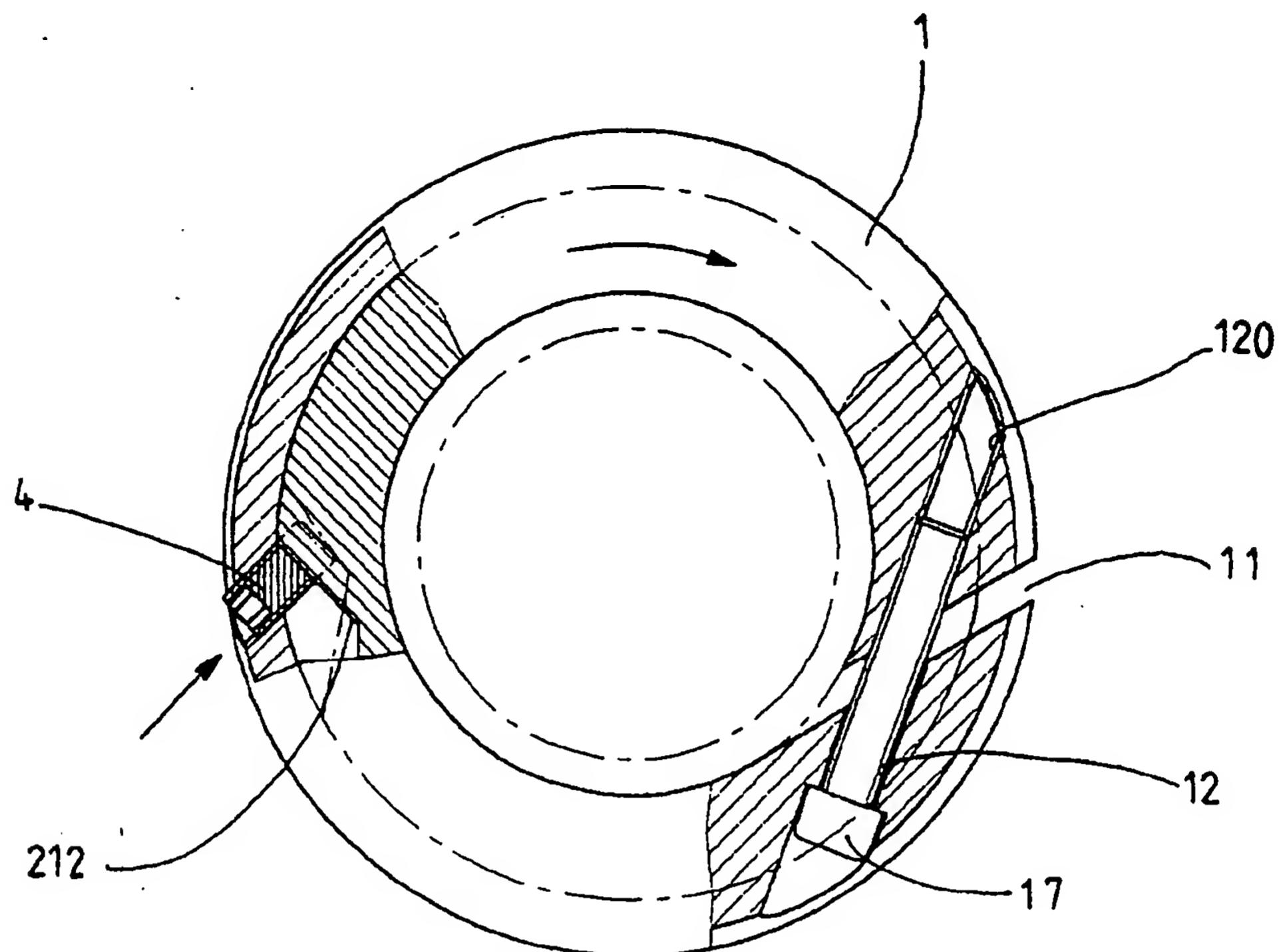


FIG.4

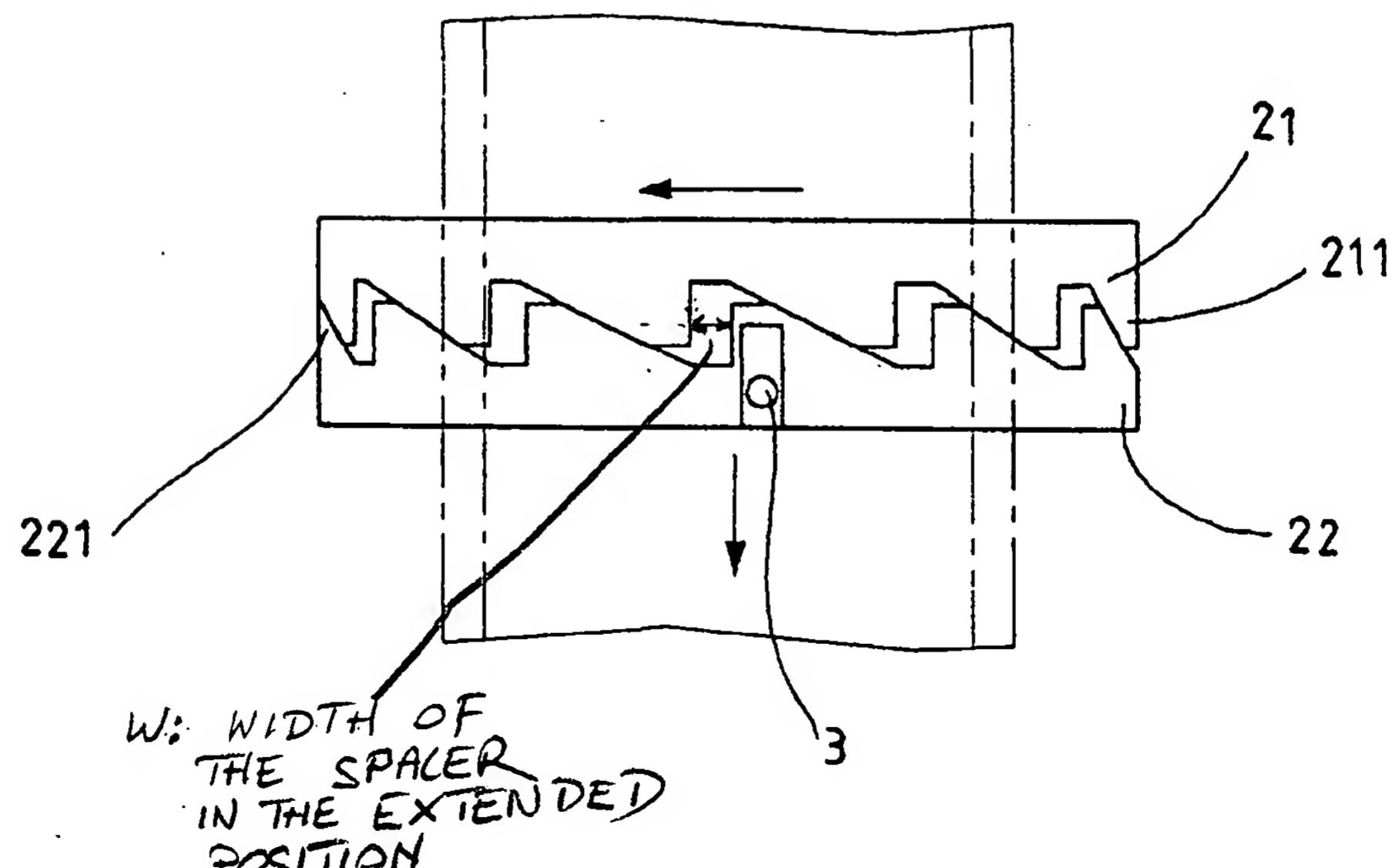


FIG.5 (EXTENDED POSITION)